

C4 19. (THREE TIMES AMENDED) A browser to display a Web page on a display unit, the Web page being accessed via the Internet by an associated URL, the browser comprising:

a definition management note to store a number of times of display of any Web page which has been accessed by an associated URL, wherein the definition management note stores a plurality of URLs that respectively correspond to a plurality of threshold values that are associated with each URL; and

an importance degree control unit to count a number of times of display of any Web page accessed by the URL, wherein said importance degree control unit outputs the number for storage by said definition management note,

wherein the importance degree control unit executes a process of setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display of any Web page accessed by the URL exceeds one of the plurality of corresponding stored threshold values associated with the URL.

REMARKS

In the Office Action mailed on October 9, 2002, claims 2-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan et al. (U.S. Patent No. 6,421,675 B1) ("Ryan") in view of Gaffaney et al. (U.S. Patent No. 5,634,008) ("Gaffaney"). The foregoing rejections are respectfully traversed.

Claims 2-20 are pending in the subject application, of which claims 2, 13, 16, and 19 are independent. Claims 2, 13, 16, and 19 are amended. Care has been exercised to avoid the introduction of new matter. A Version With Markings To Show Changes Made to the amended claims is included herewith.

Differences Between Cited References and Claimed Invention:

Claim 2 of the subject application (as amended herein) recites that "the importance degree control unit executes a process of setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display of any image accessed by the unique identifying information exceeds one of the plurality of corresponding stored threshold values associated with the image."

Claim 13 of the subject application (as amended herein) recites "executing a particular

process when the counted number of times exceeds one of threshold values associated with the URL, said particular process including setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display of the Web page exceeds the one of the threshold values."

Claim 16 of the subject application (as amended herein) recites "setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display exceeds the threshold number."

Claim 19 of the subject application (as amended herein) recites that "the importance degree control unit executes a process of setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display of any Web page accessed by the URL exceeds one of the plurality of corresponding stored threshold values associated with the URL."

Ryan discusses a method of updating an internet search engine database with the results of a user's selection of specific web page listings from the general web page listing provided to the user as a result of his initial keyword search entry (Ryan, Abstract). The Examiner stated that Ryan does "not specifically mention the threshold values corresponding to the identifying information, or the subsequent setting of a mark when the counted number of times exceeds one of these threshold values" (Office Action, p. 3, item 6).

Gaffaney discusses determining when a threshold condition representing the occurrence of a user specified number of events for a monitored activity has occurred within a specified time interval (Gaffaney, Abstract). The Examiner asserts that Gaffaney shows "threshold values corresponding to identifying information and setting a mark when a count exceeds a threshold value, to determine relevance or importance to a network site (Office Action, p. 3, item 6).

However, any combination of Ryan and Gaffaney (see discussion thereto below) does not disclose or suggest setting any mark when a count exceeds a threshold value and displaying the mark on a display unit. Gaffaney, in the section cited by the Examiner, discusses determining whether a value exceeds a threshold, but does not disclose or suggest setting any mark as a result or displaying the mark on a display unit. Therefore, claims 2, 13, 16, and 19 of the subject application (as amended herein) are patentably distinguishable over Ryan and Gaffaney, taken alone or in combination.

Dependent claims 3-12, 14-15, 17-18, and 20 are allowable in part based on their dependency, directly or indirectly, from one of allowable claims 2, 13, 16, and 19.

Lack Of Motivation To Combine The References:

MPEP § 706.02(j) sets forth the contents of a rejection under § 103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure" (emphasis in original).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why Ryan and Gaffaney would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner's sole support for such a combination is that "it would provide a convenient way to determine importance or relevance of a network site in a system that updates counts of network site access" (Office Action, p. 3, item 6).

The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.


Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 3.6.2003

By: 
Matthew Q. Ammon
Registration No. 50,346

700 Eleventh Street, NW, Suite 500
Washington, D.C. 20001
(202) 434-1500



VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please AMEND claims 2, 13, 16, and 19. The remaining claims are reprinted, as a convenience to the Examiner, as they presently stand before the U.S. Patent and Trademark Office.

1. (CANCELED)

2. (THREE TIMES AMENDED) A viewer to display images [which are] on a display unit, the images being accessible by an associated identifying information, [said] the viewer comprising:

a definition management note to store a number of times of display of any image which has been accessed by an associated unique identifying information; and

an importance degree control unit to count a number of times of display of any image accessed by the unique identifying information, wherein [said] the importance degree control unit outputs the number for storage by [said] the definition management note,

wherein [said] the definition management note stores a plurality of identifying information that is associated with the image which respectively corresponds to a plurality of threshold values that [is] are associated with the image, and

wherein [said] the importance degree control unit executes a process of setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display of any image accessed by the unique identifying information exceeds one of the plurality of corresponding stored threshold values associated with the image.

3. A viewer as claimed in claim 2, wherein each of the threshold values stored in said definition management note have an associated displayable image as a counting object.

4. A viewer as claimed in claim 3, said viewer being a browser that displays Web pages accessed via the Internet as the images and each identifying information being a URL, wherein

said definition management note defines an importance degree for each URL which has been accessed a number of times exceeding an associated threshold value, and

said importance degree control unit executes a process corresponding to an importance

degree mark for each URL having an associated importance degree.

5. A viewer as claimed in claim 3, said viewer being a browser that displays Web pages accessed via the Internet as the images and each identifying information being a URL, wherein

an importance degree mark corresponding to an importance degree is defined for each URL stored in said definition management note, and

said importance degree control unit selects processes for each of the importance degree marks depending on the number of times of display.

6. A viewer as claimed in claim 3, said viewer being a browser that displays Web pages accessed via the Internet as the images and each identifying information being a URL, wherein

said importance degree mark is a program object which notifies users that a number of times of display of associated Web pages is indicated by a density of color, or by characters or images being displayed within the associated Web page.

7. A viewer as claimed in claim 3, said viewer being a browser that displays Web pages accessed via the Internet as the images and each identifying information being a URL, wherein

said importance degree control unit updates the counted number of times of display of a corresponding Web page before the Web page is displayed with the browser, and

said importance degree control unit executes a process designated by said importance degree mark on the basis of the counted number of times of display.

8. A viewer as claimed in claim 3, said viewer being a browser that displays Web pages accessed via the Internet as the images and each identifying information being a URL, wherein

said importance degree control unit can add, change, and delete information in the definition management note relating to a Web page being displayed by said browser.

9. A viewer as claimed in claim 2, wherein said viewer is a browser that displays Web pages accessed via the Internet as the images, and said importance degree control unit

counts URLs as the unique identifying information, said viewer further comprising:

an automatic registration control unit to register Web pages that have exceeded the stored threshold value to a bookmark.

10. A viewer as claimed in claim 9, wherein said automatic registration control unit is provided with a sorting function to rearrange a registration sequence of Web pages in the bookmark depending on the number of times of display.

11. A viewer as claimed in claim 10, further comprising:
an automatic page generating unit to automatically generate Web pages from corresponding URLs registered in the bookmark.

12. (ONCE AMENDED) A viewer as claimed in claim 2, wherein said viewer is a browser that displays Web pages accessed via the Internet as the images, and said importance degree control unit counts URLs as the identifying information, said viewer further comprising:

an automatic registration control unit to register Web pages that have been displayed greater than a threshold value to a bookmark.

13. (THREE TIMES AMENDED) A viewing method using a browser to display Web pages on a display unit, the Web pages having associated URLs, comprising:

storing a plurality of threshold values for each of the associated URLs;

counting a number of times of display of a Web page accessed by an associated URL;

and

executing a particular process when the counted number of times exceeds one of threshold values associated with the URL, said particular process including setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display of the Web page exceeds the one of the threshold values.

14. (ONCE AMENDED) The viewing method according to claim 13, wherein the particular process notifies users that the threshold value of a number of times of display has been exceeded through display in a Web page.

15. The viewing method according to claim 14, wherein the counted number of times

of display of a corresponding Web page is updated before the Web page is displayed with the browser.

16. (THREE TIMES AMENDED) A display method [of] for displaying an image [which is] on a display unit, the image being accessible by an associated unique identifying information, [said] the display method comprising:

storing a plurality of threshold numbers that [is] are associated with the associated unique identifying information;

storing a number of times of display of any image which has been accessed by an associated unique identifying information; and

counting a number of times of display of any image accessed by the unique identifying information;

comparing the number of times of display of an image accessed by the unique identifying information with a threshold number associated with the unique identifying information; and

setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display exceeds the threshold number.

17. (ONCE AMENDED) The viewing method according to claim 16, wherein the counting counts a number of times of display of Web pages accessed with a browser via the Internet, and wherein the unique identifying information is a URL, and further comprising:

registering a Web page which has been displayed greater than the threshold number to a bookmark.

18. (ONCE AMENDED) The viewing method according to claim 16, wherein said browser displays Web pages via the Internet, further comprising:

notifying users that a threshold value of a number of times of display has been exceeded through display in a Web page.

19. (THREE TIMES AMENDED) A browser to display a Web page on a display unit, the Web page being accessed via the Internet by an associated URL, [said] the browser comprising:

a definition management note to store a number of times of display of any Web page which has been accessed by an associated URL; wherein the definition management note

stores a plurality of URLs that respectively correspond[s] to a plurality of threshold values that [is] are associated with each URL; and

an importance degree control unit to count a number of times of display of any Web page accessed by the URL, wherein said importance degree control unit outputs the number for storage by said definition management note,

wherein the importance degree control unit executes a process of setting an importance degree mark, which is to be displayed on the display unit, when the counted number of times of display of any Web page accessed by the URL exceeds one of the plurality of corresponding stored threshold values associated with the URL.

20. (ONCE AMENDED) The browser according to claim 19, wherein
said importance degree control unit executes a process of an importance degree mark when the counted number of times of display of any Web page accessed by a URL exceeds a corresponding stored threshold value.
